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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/698,419 | 11/03/2003 | Chul H. Choe | | 2811 |
| 37437 | 7590 | 09/29/2005 | EXAMINER | |
| CHUL HONG CHOE 10043 WATERFORD DR. ELLIOTT CITY, MD 21042 | | | SUHOL, DMITRY | |
| | | ART UNIT | | PAPER NUMBER |
| | | 3725 | | |

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/698,419 | CHOE, CHUL H. | |
| | Examiner | Art Unit | |
| | Dmitry Suhol | 3725 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>11/3/2003</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, there is no antecedent basis for "the circumference of the end" since possible multiple ends are being claimed.

Regarding claim 8, there is no antecedent basis for "the material of construction" since it is not clear if applicants are talking about the nail or the handle portion or some other piece of the device.

Regarding claim 17, there is no antecedent basis for "the devices" and reference to fig. 8 in the claims is not appropriate since it is the claims that define the invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4, 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by McKew '461. Mckew discloses a nail enhancement training device containing all of the claimed elements including with reference to claim 1, a cylindrical handle having a circumference on at least one end (48), a multiplicity of nails simulating finger nails in shape and size, having a proximal and distal ends (nails 25), nails attached to at least one end of the handle by their proximal ends (figure 10), nails arrayed about the circumference of the ends (figure 4, where both ends of member 48 receive the simulated nails). Distal ends of the nails being a specific shape, as required by claim 3, are shown in figures 10 and 17 as nails 25. The weight of the device approximates that of a human finger, as required by claim 4, is considered encompassed by Mckew since human fingers vary in size and weight and since McKew clearly envisions that his device simulate a human finger. The length being approximately 115 cm and the diameter being approximately 20 cm, as required by claim 7, are considered to be encompassed by the dimensions disclosed by McKew at col. 5, lines 8-12. The material of construction being plastic, as required by claim 8, is described at col. 5, lines 14-17. Regarding claims 9-10, it is considered that lacking any further distinguishing features, the nail 25 of Mckew encompasses that claim limitations.

Claims 1, 3, 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas '253. Thomas discloses a cylindrical nail display device (10) containing all of the claimed elements including artificial nails (27) positioned around the circumference of the device with a gap (figure 2) in between each nail and having a shape as required by claims 3 and 9 and the required texture of claim 10.

Claims 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas '253. Thomas discloses a nail polish display stand containing all of the claimed elements including applying nail enhancements (polish carried by nails 27) to two or more nails (27) on a nail enhancement training device (10) and allowing a customer to examine the nails (are inherent with the display of Thomas).

Claim 17 is rejected under 35 U.S.C. 102(e) as being anticipated by Riester '526. Riester discloses nail enhancement display devices (20) which are arranged in a row (figure 1) that is stringed together by a connecting material (13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKew '461 in view of Riester '526. McKew discloses all of the claimed elements, as stated above, and further including the use of nail enhancement materials (nail polish as pointed to at col. 3, lines 20-23). McKew fails to disclose instructional materials and tools for the application of the nail enhancement materials as required by claim 11. However it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have included nail enhancement materials (such as nail polish) and tools for the application of nail enhancement materials (nail polish brush) since McKew clearly states that nail polish may be applied to his device (col. 3, lines 20-23) and since Riester clearly teaches that packaging such device with nail polish bottles (col. 3, lines 18-25, known to have brushes therewith see U.S. Patent 2,248,011) is known. It would have been further obvious to include instructional materials with the device of McKew for the purpose of providing directions to a user since the device of McKew is clearly for training purposes and since providing instructions with various article for the purpose of providing directions to a user is notoriously known in the art.

Regarding claim 12, the steps of grasping the nail training device with one hand and applying nail enhancement materials to the nail with the other hand would have been obvious since McKew clearly teaches that his device is intended to have polish (considered to be nail enhancement materials) applied thereto (col. 3, lines 20-23) and since Riester teaches that such technique is conventional (col. 3, lines 51-52).

Regarding claims 13-14, the steps of removing and reapplying "nail enhancement materials" as claimed would have been obvious to facilitate training and since the examiner takes official notice that the repeat of such step is conventional.

Claims 2, 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas '253. Thomas fails to explicitly teach a specific nail thickness as required by claim 2, a gap distance as required by claim 5 and a nail width as required by claim 6. However, it would have been obvious to utilize nails with the above dimensions in the device of Thomas for the purpose of displaying realistic nails especially since the examiner takes official notice that nails having dimensions within the above ranges are known in the art. Additionally, it would have been obvious to have a gap of approximately 2 mm in the device of Thomas since Thomas does not place any size restrictions on his gaps (28) and since applicants do not disclose any particular advantage or criticality in the gap size in their invention.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas '253. The step of a customer selecting a nail enhancement is obvious in Thomas as his display is intended to be used to display nail enhancement polish to customers (col. 1, lines 5-37) and the selection of one would only depend on a customers taste and price of services.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dmitry Suhol
Examiner
Art Unit 3725

ds